



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,961	03/19/2004	Toshihisa Nagashii	0505-1278P	6485

2292 7590 12/16/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

LUM VANNUCCI, LEE SIN YEE

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,961	Applicant(s) NAGASHII ET AL.	
	Examiner Lee Lum	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,16,21 is/are rejected.
- 7) ☒ Claim(s) 3,15 and 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. An Amendment was filed 9/20/05 in which Claim 4 was also cancelled, and Claim 21 added.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elements in the following recitations must be shown, or the features canceled from Claims 1 and 16:

"a distance between lower portions at the longitudinal intermediate position of each pipe member is greater than a distance between than [sic] upper portions" (emphasis added).

Fig 5 fails to clearly depict these elements because it is unclear exactly what constitutes the "lower portions", "upper portions", and "distance between [these portions]. It is highly recommended that additional drawings and/or amendments be submitted to clearly illustrate this limitation.

It is also noted that fig 5 may be erroneous. As best understood, according to fig 3, figure 5 should depict a crosssection of the pipe members, as viewed from the rear, to the front, of the vehicle, the crosssection showing a "multi-sided" figure, very roughly resembling a circle. However, the figure depicts a sort of crosssection of each pipe member in a longitudinal direction (which is unclear), apparently as viewed from the front, to the rear of, the vehicle (as evidenced from the engine structure which is enclosed between the pipes). This depiction also appears to indicate that the pipe members are substantially vertically-oriented, and not oriented at a slight angle as depicted in fig 1. Clarification is required.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

3. The disclosure is objected to because of the following informalities:

In Claim 1, line 18, after "between", "than" should be deleted.

In Claim 5, the dependency should be amended to an existing claim.

In Claim 10, "rear portions" and "front end portions" lack antecedent basis.

4. The amendment filed 9/20/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the inner wall... is formed with a...continuously inwardly and downwardly facing concave surface...each pipe member". Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 3611

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 5-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claims 1 and 16, the limitation "a distance between lower portions at the longitudinal intermediate position of each pipe member is greater than a distance between than [sic] upper portions", is unclear because the drawings fail to clearly illustrate the respective elements.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 5-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1 and 16, the limitation "a distance between lower portions at the longitudinal intermediate position of each pipe member is greater than a distance between than [sic] upper portions", is unclear because the drawings fail to clearly illustrate the respective elements. See paragraph 2.

In the same claims, "the inner wall... is formed with a...continuously inwardly and downwardly facing concave surface..." is unclear because the characteristics cannot be identified in the drawings. This recitation is also new matter because the language was not originally provided, nor evident in the drawings (see paragraph 4).

In Claim 21, "upper portions of the inner walls of the pipe members are closer at tops than at lower portions of the pipe members" is unclear (and despite an attempt to correct "tops").

Art Unit: 3611

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-12, 14, 16 and 21 (1, 16 and 21 as *best understood*) are rejected under 35 U.S.C. 102(e) as being anticipated by limuro 6679347.

Re **Claims 1, 2, 5-12, 14, 16**, limuro discloses a motorcycle frame comprising
Headpipe 12 supporting front fork 2,
The front fork supporting front wheel 14 through a (steering) shaft (unidentified, inherent),
Rear wheel 17,
Pair of right 17, and left pipes 16, connected to the headpipe (fig 3),
Being curved in an outwardly convex shape at a longitudinally intermediate position (fig 4), when viewed from the top,
Wherein a distance between lower portions at the longitudinal intermediate position of each pipe member is greater than a distance between upper portions, as *best understood*, and including,
Inner wall (unidentified in fig 5) having a substantially continuous inwardly and downwardly facing concave surface with respect to a vertical direction of the pipe,
Outer wall (unidentified in fig 5) extending substantially a substantially continuous outwardly and downwardly facing convex surface, substantially parallel with the inner wall,
Engine 10 mounted in space 55 between lower portions of the pipes,

Art Unit: 3611

First crosspipe (unidentified in fig 1; crosspipe adjacent headpipe)) extending across front portions of the pipes,

Seat rails, rear portions of frame element 26, connected to rear end portions of the pipes,

Right, left gussets (unidentified in fig 2; connecting portions to pipes) extending rearward and downward from the headpipe,

Right, left pivot plates 20, 21 extending downward from rear portions of the pipes (fig 1),

Second crosspipe 51 extending across upper portions of the pivot plates (fig 6),

Third crosspipe 53 extending across lower portions of the pivot plates (fig 6),

Right, left main frame 11, including gussets welded to the pipes, and pipe portions 64 integral with the pivot plates, and welded to rear ends of the pipes (fig 6),

Rib 75c partitioning an interior of each pipe (fig 4).

As best understood, re **Claim 21**, the reference discloses the elements as provided above, and further includes

The pipe members as having a substantially prismatic shape (figs 3 and 5),

Where the inner wall has a substantially continuous concave curve (fig 5) through an overall length of the pipes, and with respect to a vertical direction of the pipes, and,

The outer wall extending substantially parallel with the inner wall, and

Upper portions of the inner wall are closer at tops than at lower portions of the pipes, as *best understood*.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over limuro in view of Nagashii 6502658 .

The reference does not disclose vertical ribs in the pipe members, while Nagashii shows this type of reinforcement 52-54 in fig 4. It would have been obvious to one with ordinary skill in the art at the time the invention was made to include vertical ribs, to provide increased structural integrity with respect to a vertical direction of the pipe members, thus increase longevity of the vehicle frame. Ribs reinforcing various directions/aspects of structural elements are very well-known.

9. **Claims 3, 15 and 17-20** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior art does not disclose the vehicle described above further comprising, *inter alia*, engine hangers secured to front ends of the pipe members.

10. **RESPONSE TO REMARKS**

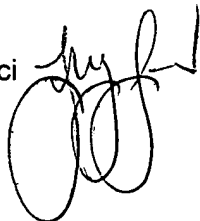
Examiner reiterates her rejections using limuro, with some slight modifications.
Applicant is asked to note allowable subject matter.


11. **Communication with the Examiner/USPTO**

Any inquiry concerning this communication, or others, should be directed to Ms. Lum at 571 272-6649, M-F, 9-5. If she cannot be reached, her supervisor, Ms. Lesley Morris, may be reached at 571 272-6651. Our central fax number is 571 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. For unpublished applications - private PAIR only. For published applications - private or public PAIR. For more information re PAIR - <http://pair-direct.uspto.gov>. Questions re private PAIR - contact the Electronic Business Center (EBC) at 866 217-9197.

Ms. Lee S. Lum-Vannucci
Examiner
12/12/05




LESLEY D. MORRIS
SUPERVISOR, PATENT EXAMINER
TECHNICAL CENTER 3600